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REMARKS

Claims 1-38 are currently pending in the subject application and are presently under consideration. Claims 20-22 and 28-38 have been withdrawn pursuant to a Restriction Requirement. Claims 1-3 and 23 have been amended herein. A listing of all pending claims is found at pages 2-8 of this Reply. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection to the Drawings

A set of formal drawings will be submitted upon allowance of the pending claims.

II. Rejection of Claims 1-5 and 9-11 Under Non-Statutory Double Patenting

Claims 1-5 and 9-11 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6-8, 21, 54, 64, and 78 of U.S. Patent Application No. 09/232,142. Withdrawal of this rejection is respectfully requested in view of the Terminal Disclaimer regarding U.S. Patent Application No. 09/232,142 filed herewith.

III. Rejection of Claims 1, 6, and 18 Under Non-Statutory Double Patenting

Claims 1, 6, and 18 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 28 of U.S. Patent No. 6,101,483. Withdrawal of this rejection is respectfully requested in view of the Terminal Disclaimer regarding U.S. Patent No. 6,101,483 filed herewith.

IV. Restriction/Election

The Examiner requires restriction to one of the following two groups of claims:

Group I - Claims 1-19 and 23-27, drawn to "a personal shopping system (or a shopping method) for servicing customer at shopping establishment and remote locations over a communication network", classified in class 705, subclass 26.

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Group II – Claims 20-22 and 28-38, drawn to a portable system using a scanner for communications, classified in class 235, subclass 462.01.

Applicants hereby elect to prosecute Group I – Claims 1-19 and 23-27 on the merits with traverse.

V. Rejection of Claims 21 and 23 Under 35 U.S.C. §112, second paragraph

Claim 21 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 21 has been withdrawn from consideration herein pursuant to the Restriction Requirement. Withdrawal of this rejection is respectfully requested.

Claim 23 lacks an antecedent basis for “the system having a point-of-sale...” in line 3 of claim 23, page 116. Claim 23 has been amended herein to cure any informalities. Withdrawal of this rejection is respectfully requested.

VI. Rejection of Claims 1, 7-8, and 13-14 Under 35 U.S.C. §103(a)

Claims 1, 7-8, and 13-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa et al. (U.S. Patent No. 6,236,974). It is submitted that this rejection should be withdrawn for at least the following reasons. Kolawa et al. does not teach or suggest all the limitations set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

In particular, Kolawa et al. does not teach or suggest at least one establishment or

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means for communicating with at least one remotely located shopping terminal via a telephone;

means for communicating voice data between said controlling means and said at least one remotely located shopping terminal;

means for remotely ordering goods to be gathered by store personnel at said shopping establishment; and

means for communicating with said at least one remotely located shopping terminal over the Internet.

15. (Original) The shopping system according to claim 14, wherein said controlling means comprises:

means for starting and restarting the operation of said shopping system;

means for terminating the operation of said shopping system;

means for displaying the operational status of said shopping system;

means for controlling the day-to-day operations and maintenance tasks of the shopping system;

means for displaying the status of communications related to said shopping system;

means for preparing said shopping system to accept an upcoming day's transactions;

means for transferring price data files from the POS system to said controller; and

means for allowing a system operator to disable checking on transactions by said controller so as to speed up checkout processing during busy periods.

16. (Original) The shopping system according to claim 14, wherein said controlling means comprises means for processing transactions related to said shopping establishment including start of day processing, normal store processing, end of day processing and overnight processing.

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17. (Original) The shopping system according to claim 14, wherein said means for remotely ordering goods is used to generate a picking list from a home computing terminal having access to the Internet.

18. (Original) The shopping system according to claim 1, wherein said shopping terminal is a portable terminal, said portable terminal comprising means for freely associating with a corresponding communications network.

19. (Original) The shopping system according to claim 1, wherein said shopping terminal comprises means for fingerprint identification.

20. (Withdrawn)

21. (Withdrawn)

22. (Withdrawn)

23. (Currently Amended) A method for shopping at a shopping establishment having a centrally-controlled shopping system for processing shopping transactions and orders from shopping establishment and remote locations, the centrally-controlled shopping system having a point-of-sale (POS) system located in the shopping establishment, at least one establishment or remotely located portable shopping terminal, and a controller in communication with the POS system and the at least one terminal via at least one communications network, said method comprising:

- associating the terminal with the at least one network and a customer;
- scanning one or more items to be purchased using the terminal;
- returning the terminal to the terminal receptacle;
- collecting a receipt corresponding to the scanned items; and
- purchasing the scanned items at a customer check-out station.

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remotely located portable shopping terminal for acquiring shopping related data, as recited in claim 1. Kolawa et al. discloses a kitchen computer 10, which is mounted into a kitchen counter, cupboard, or appliance (col. 3, lines 10-11). The kitchen computer 10 is connected to three different types of computer systems (store servers, a remote control system, and information servers) existing outside the home via a network connection 40. There is nothing in Kolawa et al. which teaches or suggests a portable terminal for acquiring shopping related data.

For at least the aforementioned reasons, Kolawa et al. does not make obvious independent claim 1 or claims 2-19, which depend therefrom. Withdrawal of this rejection and allowance of claims 1-19 are respectfully requested.

VII. Rejection of Claim 19 Under 35 U.S.C. §103(a)

Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolawa et al. (U.S. Patent No. 6,236,974), in view of the Official Notice. It is submitted that this rejection should be withdrawn for at least the following reasons. Claim 19 directly depends from independent claim 1, which is believed to be allowable. Therefore, claim 19 is not obvious over Kolawa et al. in view of the Official Notice. Withdrawal of this rejection and allowance of claim 19 are respectfully requested.

VIII. Rejection of Claims 23-27 Under 35 U.S.C. §103(a)

Claims 23-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Official Notice. It is submitted that this rejection should be withdrawn for at least the following reasons.

The Examiner has taken Official Notice that UPS and amazon.com Inc. make obvious claims 23-27. Applicant respectfully submits neither UPS nor amazon.com Inc. teaches or suggests scanning one or more items to be purchased using the portable terminal; collecting a receipt corresponding to the scanned items; and purchasing the scanned items at a customer check-out station, as recited in independent claim 23. Accordingly, Applicants' representative traverses the Official Notice and respectfully

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requests showing of reference(s) under M.P.E.P. § 2144.03 to support the Examiner's assertion, or in the alternative, withdrawal of this assertion from the rejection.

IX. Objection of Claims 12 and 15-17

Claims 12 and 15-17 are objected to as being dependent upon a rejected base claim. As claims 12 and 15-17, are directly or indirectly dependent upon independent claim 1, which is now believed to be allowable per the aforementioned reasons, it is believed that claims 12 and 15-17 are now also allowable. Withdrawal of this objection is respectfully requested.

X. Conclusion

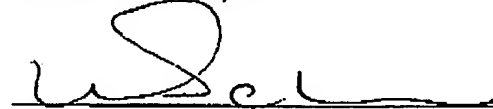
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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